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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,213	11/20/2003	Jillian Jacobson-Altit	1422-2U	9010
31292 7590 05/05/2008 CHRISTOPHER & WEISBERG, P.A. 200 EAST LAS OLAS BOULEVARD SUITE 2040 FORT LAUDERDALE, FL 33301				
EXAMINER				
MERCIER, MELISSA S				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
05/05/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/718,213

**Applicant(s)**

JACOBSON-ALTIM, JILLIAN

**Examiner**

MELISSA S. MERCIER

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-2, 56, 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt of Applicants Remarks, Amended Claims and the Declaration filed under 1.132 are acknowledged. Claims 1-6 and 11-17 remain pending in this application. Claims 3-4 remain withdrawn from consideration. Applicant has cancelled claims 7-10. Therefore, claims 1-2, 5-6, and 11-17 are under prosecution in this office action. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 5-6, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanni (US Patent 5,631,012) in view of Deckers et al. (US Patent 6,372,234).

Shanni discloses lip pomade comprising 5.00% ozokerite, 10.00% isopropyl myristate, and a fragrance/flavor portion (Example 6). Pomade is defined as a perfumed oil or ointment by dictionary.com and would therefore be considered a liquid formulation.

Shanni does not disclose the use of a colorant, preservative, in the formulation.

Deckers teach a cosmetic composition comprising oil bodies suitable for use in lipsticks, lip-glosses, lip balms and lip pencils.

Deckers cosmetic composition further comprises fragrances. Deckers defines a fragrance as any component reacting with the human olfactory sites and imparting a pleasurable odor, essence, or scent. Fragrances taught by Deckers include linear and cyclic alkenes, primary, secondary, and tertiary alcohols, ethers, esters, ketones, nitrites, and saturated and unsaturated aldehydes" (column 17, lines 18-52).

The use of a preservative in order to treat against contamination by bacteria, fungi and viruses is disclosed (column 13, lines 21-26).

Deckers further discloses the addition of pigments, including titanium dioxide, zinc oxide, black, yellow, red and brown iron oxides, for example (column 22, lines 47-56); antioxidants, including plant extracts (column 23, lines 1-12).

Deckers teaches the use of esters including  $C_8$ - $C_{30}$  alkyl esters of  $C_8$ - $C_{30}$  carboxylic acids;  $C_1$ - $C_6$  diol monoesters and diesters of  $C_8$ - $C_{30}$  carboxylic acids;  $C_{10}$ - $C_{20}$  alcohol monosorbitan esters,  $C_{10}$ - $C_{20}$  alcohol sucrose di- and tri- esters;  $C_{10}$ - $C_{20}$  alcohol sucrose mono-, di-, and tri- esters; and  $C_{10}$ - $C_{20}$  fatty alcohol esters of  $C_2$ - $C_6$  2 hydroxyacids, examples included sorbitan esters (column 16, lines 41-53). It is the examiners position that since sorbitan esters are disclosed and it is known in the art that they are useful in cosmetic formulations, it would have been obvious to substitute on for another with the expectation that they would function similarly.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of bodying agents, odorants, and flavorants to prepare a composition

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containing for topical treatment to the lips because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of commonly known to be used in the art of lip stick/gloss compositions. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues the Shanni reference requires vernix as an essential material to improve skin softness, flexibility, plasticity and moisturization. While the examiner agrees the Shanni employs a synthetic vernix material, Shanni discloses it to be useful for its moisturizing properties. The instant claims recite the use of an alkyl ester, which is art recognized as an emollient, a moisturizing component. Therefore, the instant

claims recognize the need for a moisturizing property of the lip care formulation. Furthermore, no evidence has been submitted that would show the removal of the particular moisturizer taught by Shanni would have a negative effect on the composition to function for application to the lips. Applicant has further argued vernix would be completely alien to a lip gloss. The examiner respectfully disagrees since Shanni disclosed it use in a lip care formulation as discussed in the body of the rejection above.

Applicant additionally argues the use of vernix in a cosmetic that is applied to lips is both aesthetically objectionable as well as likely to be unsafe, particularly when it is considered that it is of internal origin within the uterus and passes through the mother's birth canal. Therefore, it could be subject to hematological contamination and conceivably could be implicated in non-hematological infections such as human papilloma viruses, gonorrhea, Chlamydia and others. In view of these disease implications its use on lips should be avoided. While the examiner can appreciate the desire to reduce contain nation from lip care formulation, it appears that Applicant is not reading Shanni for all that it contains. Shanni discloses the vernix used can be a synthetic material prepared by homogenizing the active components from commercially availably sources. The formulation is also disclosed as being bacteria free (column 7, lines 37-45).

### ***Response to Amendment***

The Declaration under 37 CFR 1.132 filed January 24, 2008 is insufficient to overcome the rejection of claims 1-2, 5-6, and 11-17 based upon obviousness over

Shanni in view of Decker as set forth in the last Office action because: the instant claims do not recite any kind of stability requirement. The Declaration employs subjective analysis of the composition and is not required as scientific data. Further, Shanni discloses the use of natural and synthetic forms of vernix. Applicant has not provided any data as to the effects of the synthetic form being employed in a cosmetic formulation.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615